

**REMARKS**

***Specification***

Applicant cancels (without prejudice) claims 9, 10 and 13, thereby rendering moot the objection under 37 C.F.R. § 1.71, which objection Applicant respectfully requests the Examiner now to reconsider and withdraw.

In view of the cancellation of claim 13, the rejection thereof under 35 U.S.C. § 112, first paragraph, also is rendered moot, and should be withdrawn for this reason.

***Claim Rejections - 35 U.S.C. § 112***

Applicant has canceled claims 9-17 thereby rendering moot their rejection under 35 U.S.C. § 112, second paragraph.

Applicant respectfully traverses this rejection insofar as it is directed to the use of the alternative. MPEP §2173.05(h) states in pertinent part:

Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims.

Applicant respectfully submits that the alternative expression here certainly presents "no uncertainty or ambiguity", i.e., are not in any way "indefinite". However, if the Examiner insists, Applicant will rephrase the alternative expression as a Markush group which is unquestionably acceptable.

***Claim Rejections - 35 U.S.C. § 103***

The Examiner rejected claims 8-17 under 35 U.S.C. § 103(a) as being unpatentable (obvious) over Conti '745 in view of Parker '735 and Focke '823.

The Examiner qualifies this rejection as being limited to "the extent that the Examiner can determine the scope of the claims".

Applicant respectfully **traverses** this rejection insofar as it may be applied to the amended claim 8 and to the new claims 18-24.

The primary basis of this traversal is that a rejection under 35 U.S.C. § 103(a) requires that the applied references teach, or at least suggest, **all of the limitations** of the rejected claims.

Applicant respectfully submits that clearly such is **not** the case here with respect to the amended claim 8 and new claims 18-24.

#### **OVERVIEW**

The design of the claimed pack is based on an innovative idea that is not encountered in the prior art. It deals with the solution to the problem increasingly encountered in practice of identifying cigarette packs with respect to their origin. The invention employs a technology that can be implemented relatively simply for identifying the origin of hinge-lid cigarette packs.

Its constructive design principle is that an identifier applied to the pack for identifying its origin can be **easily changed** without having to alter any other design features of the pack. Of further significance is that the application of a variable identifier to the pack does not require the use of any additional carrier, i.e., additional pack parts, blanks, pack inserts etc. This is achieved by providing the inner blank or inner liner with an identifier which, by virtue of its appropriate placement and the design of the pack itself, can be seen from the outside. This solution rests on the knowledge that the pack blank for forming the hinge-lid pack and the blank for the collar (frame) cannot be further altered with respect to their configuration in the region of a packaging

machine for producing packs. The blank for the pack itself is supplied in its finished design by the printing company, usually as a stack of blanks. This is introduced into the packaging machine and processed during the production of the packs.

During the production of packs within the meaning of the invention, the prefinished pack blanks with the complete design are provided with punchings or openings, as is the collar. Only the inner blank is available for the application of the identifier. If this inner blank is made of paper, an identifier or marking can be applied by printing, i.e., by means of a simple printing unit in the packaging machine. However, in the majority of cases the inner blank is made of tin foil. In the case of this packaging material, identifiers, markings etc. can be applied by embossing the material. Every packaging machine is equipped with an embossing unit or an embossing assembly which applies a clearly visible embossment to the tin foil material provided as a material web, specifically at a position aligned with the openings of the blank and collar.

According to the claimed invention, and particularly in the case of tin foil webs, a selected and, with the help of the embossing assembly, variable marking 38 is applied which relates to the origin of the pack or some other identification feature and which is visible from the outside of the finished closed pack even though it has been applied to the inner wrapper.

In the exemplary embodiment of Fig. 1, that is to say, with an opening 36 in the region of the box front wall and a collar opening 39 in the region of a correspondingly extended collar, the openings 36, 38, involved are configured as having different geometric shapes or different dimensions. Judging by the position of the openings 36 and 38 the consumer can also recognize whether the pack has been correctly and accurately finished.

Thus, the problem addressed by Applicant's claimed invention and solved by the claimed invention involves making easily changeable a "marking" of a cigarette pack for identification of the pack's origin. This problem is not even recognized, or discussed or suggested, by the combined teachings of the applied references, much less solved by them.

***The Prior Art***

More specifically:

1. WO 02/28745 to Conti relates to a hinge-lid pack which has an opening 20 arranged on its front side. However, this opening is not defined as a closed opening in the region of the box front wall. Instead, Conti creates an opening that is bordered by a free, top edge of the box front wall, on one hand, and by a lower edge of a lid front wall, on the other, as well as laterally by side tabs. When the lid is opened, the opening becomes merely a depression in the region of the box front wall. The opening 20 of Conti '745, therefore cannot be compared to the openings 36, 37 of the claimed invention with respect to its embodiment or to its arrangement.

Furthermore, in Conti '745 the collar front wall visible in the region of the opening 20 has windows 23 which provide a view of the layer lying below it. However, in all packs, a coupon 19 is disposed at the inner side of the collar in the region of the windows 23, i.e., a separate, strip-like blank as an additional component within the pack. Accordingly, the viewer can see a small portion of the outwardly directed side of the coupon 19 through the openings 23.

In certain exemplary embodiments, namely for example those pursuant to Fig. 3, Fig. 5, Fig. 6, Fig. 7 and Fig. 8, the window 23 is configured such that it projects laterally beyond the region of the coupon. However, this fails to provide a sufficient possibility for viewing the inner

blank. In Conti ,745, therefore, the inner blank is not provided in any case with an identifier marking.

2. US 6 505 735 to Parker likewise fails to relate to Applicant's claimed subject matter. Parker '735 discloses a hinge-lid cigarette pack with an "aroma-tight" inner wrapper which is made from hermetically sealed foil. A pull-back tab is disposed as an opening aid in a region exposed when the pack is open. There is no evident relevance to Applicant's claimed invention.

3. US 6 138 823 to Focke (having the same assignee as the present application) describes a hinge-lid pack having covering tabs 54, 55, marked by punching or perforation lines, in the region of a box front wall, on one hand, and in the region of a lid front wall, on the other. The tabs 54, 55 can be first detached by the user when the pack has been opened for the first time, namely by removing the outer film wrapping common to such cigarette packs. The removal of tabs 54 and 55 reveals corresponding cutouts in the pack walls. However, these cutouts do not provide a view of the inner wrapper but, rather, of a collar front wall, on one hand, and a lid inner flap, on the other. In Focke '823, the inner wrapper of the pack remains covered even after the covering tabs have been removed, so that identifying a pack by means of a visible marking on the inner wrapper is not contemplated here, nor can it be realized.

\* \* \*

Thus, in view of the above explanation of the disparate disclosures of the three cited references relative to the claimed invention, it is clear that there would have been no motivation to combine the references as proposed by the Examiner. Furthermore, even if for some reason

the references were to be combined, there would not be produced the subject matter of claims 8 and 18-24, or subject matter which would have rendered these claims obvious. Also, and contrary to the Examiner's assertion, it is clear that Conti's coupon **cannot** be "considered [equivalent] to [Applicant's claimed] inner blank. That is, certainly an "attached coupon" is not equivalent to the Applicant's claimed "marking on the inner blank".

Applicant notes that new claim 22 recites structural details of an embodiment of the claimed "cigarette pack" having features illustrated in Figs. 1, 3, 4 and 7.

In summary, then, Applicant respectfully requests the Examiner to reconsider and withdraw all objections and rejections, and to find the application to be in condition for allowance with all of claims 8 and 18-24; however, if for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is respectfully requested to **call the undersigned attorney** to discuss any unresolved issues and to expedite the disposition of the application.

Applicant files concurrently herewith a Petition (with fee) for an Extension of Time of two months. Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this application, and any required fee for such extension is to be charged to Deposit Account No. 19-4880. The Commissioner is also authorized to charge any additional fees under 37 C.F.R. § 1.16 and/or § 1.17 necessary to keep this application pending in the Patent and Trademark Office or credit any overpayment to said Deposit Account No. 19-4880.

AMENDMENT UNDER 37 C.F.R. § 1.111  
U.S. APPLN. NO. 10/525,652

Applicant also pays the multiple dependent claim fee to cover the multiple dependent claims introduced by this Amendment.

Respectfully submitted,

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